

Attorney Docket # 3415-11

Serial No. **09/587,201**
Amdt. dated November 17, 2003
Reply to Office Action dated July 16, 2003

REMARKS/ARGUMENTS

Before the present amendment, Claims 1-47 were pending, with Claims 1, 16, 30, and 46 being in independent form, and Claims 48-62 had been previously withdrawn. In the present amendment, Claims 1, 5-11, 13, 16, 18-23, 26-27, 29-30, 32-41, 43, and 46 have been amended and Claim 47 has been cancelled. After the present amendment is entered, Claims 1-46 will be pending, with Claims 1, 16, 30, and 46 being in independent form. Reconsideration and withdrawal of the rejections are requested on the basis of the foregoing amendments and the following remarks.

In the Office Action dated 8 May 2003:

- I. The disclosure was objected to (Office Action, ¶9);
- II. The drawings were objected to under 37 CFR §1.83(a) (Office Action, ¶¶10-11);
- III. Claim 15 was rejected under 35 USC §112, first paragraph (Office Action, ¶¶13-14);
- IV. Claims 6, 7, 11, 15, 26, 37, and 47 were rejected under 35 USC §112, second paragraph, for indefiniteness (Office Action, ¶16);
- V. Claims 1-3, 6, 7, 13, 30-34, and 43 were rejected under 35 USC §102(b) as anticipated by *Wilson et al.* (US 2,589,768) (Office Action, ¶18), and, alternately, under 35 USC §103(a) as unpatentable over *Wilson et al.* (Office Action, ¶22);
- VI. Claims 46 and 47 were rejected under 35 USC §102(b) as anticipated by *Sone* (US 6,204,763) (Office Action, ¶19), and, alternately, under 35 USC §103(a) as unpatentable over *Sone* (Office Action, ¶23);
- VII. Claims 1, 8-13, 46, and 47 were rejected under 35 USC §102(b) as anticipated by *Liposky et al.* (US 2,159,279) (Office Action, ¶20);
- VIII. Claims 1-13, 15-23, 25-43, and 45 were rejected under 35 USC §103(a) as unpatentable over *Sone* in view of *Liposky et al.* (Office Action, ¶24);
- IX. Claims 14, 24, and 44 were rejected under 35 USC §103(a) as unpatentable over *Liposky et al.* (US 2,159,279) (Office Action, ¶25);
- X. Claims 1-47 were rejected under 35 USC §103(a) as unpatentable over the Peapod website in view of *Sone* and in further view of *Liposky* (Office Action, ¶26); and
- XI. It was stated that the applicant must identify any claim limitation having a meaning other than its ordinary and "accustom" meaning (Office Action, ¶¶29-30).

Attorney Docket # 3415-11

Serial No. **09/587,201**
Amdt. dated November 17, 2003
Reply to Office Action dated July 16, 2003

I. Objection to the specification

In ¶9 of the Office Action, the Examiner quotes (1) the statement "FIG. 8A is a top view of an *alternative bag* used as a means for securing the tote within the grocery box..." (emphasis added); and (2) the phrase "all of which can be used in the inventive method claimed by the elected claims" from the last submission of applicant, and then poses the question "is at least Figure 8 an alternative or not?". ¶9 ends with the statement: "[a]ppropriate correction is required".

No correction is required.

The Examiner's first quote appeared in this paragraph from the applicant's previous submission (quote is in bold type):

Furthermore, there is no genus which could comprise Species A, B, and C, except perhaps a genus of "objects used in the inventive method claimed in Claims 1-47". The tote shown in FIG. 3 (Species A) is an example of a tote which can be used for transporting groceries in the inventive method. The grocery box in FIG. 5A (Species B) is an example of a grocery box which can be used to receive and store a tote (such as the tote in FIG. 3) at a delivery destination in the inventive method. The bag in FIG. 8A (Species C) is an example of a means for securing a tote (such as the tote in FIG. 3) in a grocery box (such as the grocery box in FIG. 5A) which can be used in the inventive method. These are not different species, but different objects which are designed for different purposes, **all of which can be used in the inventive method claimed by the elected claims.**

There is no contradiction between the passage above and the passage taken from the specification ("FIG. 8A is a top view of an alternative bag used as a means for securing the tote within the grocery box..."). Withdrawal of the objection is respectfully requested.

Attorney Docket # 3415-11

Serial No. **09/587,201**
Amdt. dated November 17, 2003
Reply to Office Action dated July 16, 2003

II. Objection to the specification

The Examiner objected to the drawings under 37 CFR §1.83(a); specifically noting that the following "must be shown or the features canceled from the claim(s):" (a) "dispatching the first vehicle" as recited in Claim 1; (b) "transferring the rack with the tote thereon from the first vehicle to a second vehicle" as recited in Claim 2; and (c) "wherein the second vehicle is smaller in size than the first vehicle" as recited in Claim 3 (Office Action, ¶10).

The step of "dispatching the first vehicle" as recited in Claim 1 is adequately shown, in a preferred embodiment, as step 50 of FIG. 1 (i.e., "trailer drives to transfer point"). The step of "transferring the rack with the tote thereon from the first vehicle to a second vehicle" as recited in Claim 2 is adequately shown, in a preferred embodiment, as step 60 in FIG. 1 (i.e., "transfer totes from trailer to van").

Regarding the limitation of "wherein the second vehicle is smaller in size than the first vehicle" as recited in Claim 2 is adequately shown, in a preferred embodiment, by box 180 labeled "van" in FIG. 2, which is smaller than box 160 labeled "trailer" in FIG. 2.

After listing these three features, which are adequately shown in the drawings and, thus, are not in violation of 37 CFR §1.83(a), the Examiner "notes [that] the claims are replete with the above drawing errors" and then "highly recommends" reviewing all the claims for the same sort of errors as were found in Claims 1, 2, and 3 (Office Action, ¶11). This is problematic task for the applicant to perform — because the exemplary "errors" in Claims 1, 2, and 3 were not actually errors under CFR §1.83(a), it is unclear what sort of "errors" for which the applicant should look in the remaining claims. Furthermore, it should be noted that a patent application need not graphically depict every conceivable element of invention as long as it details essential factors; rejection of claim for lack of showing in the drawing alone is not tenable. *Harrington Mfg. Co. v White* (5th Cir. 1973) 475 F.2d 788, 177 USPQ 289, reh. den. (5th Cir. 1973) 478 F.2d 1402 and cert. den. (1973) 414 U.S. 1040, 38 L. Ed. 2d 331, 94 S. Ct. 542, 179 USPQ 705. Thus, the Examiner is respectfully requested to either withdraw the objection or provide guidance and actual examples of errors under 37 CFR §1.83(a) so that the applicant may perform the recommended task.

Attorney Docket # 3415-11

Serial No. 09/587,201
Amdt. dated November 17, 2003
Reply to Office Action dated July 16, 2003

III. Rejection of Claim 15 under §112, first paragraph

The Examiner rejected Claim 15 under 35 USC §112, first paragraph, as not described and/or enabled by the written description (Office Action, ¶13). However, the Examiner also noted that if the applicant expressly admits on the record that such procedures are well-known in the art, then this particular rejection will be withdrawn (Office Action, §14). The applicant expressly admits that such procedures are well-known in the art and respectfully requests the rejection be withdrawn.

IV. Rejection of Claims 6, 7, 11, 15, 26, 37, and 47
under §112, second paragraph

The Examiner rejected Claims 6, 7, 11, 15, 26, 37, and 47 under 35 USC §112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (Office Action, ¶16).

In ¶16(a), the Examiner alleged that the phrases "early evening" and "early morning" as recited in Claim 6 are indefinite. In response, both of the phrases have been deleted from Claim 6 in the present amendment, thereby broadening the claim. In addition, the same changes were made to Claims 22, 35, and 36.

In ¶16(b), the Examiner alleged that the phrase "6 hour radius" as recited in Claims 7, 26, and 37 is indefinite. In response, the phrase has been replaced with the term "travel radius", and the claims have been amended to define "travel radius" as "the furthest distance that one or more vehicles, including the first vehicle, can travel within approximately 6 hours".

In ¶16(c), the Examiner alleged that the phrase "the first lock" as recited in Claim 11 lacks sufficient antecedent basis. In response, Claim 11 was amended to provide correct antecedent basis. Similar amendments were made to Claims 20, 29, 33, and 41.

In ¶16(d), the Examiner alleged that "it is unknown what objects are needed to perform the claimed step of "feeding a chilled gas into at least a portion of the tote" as recited in Claim 15. As stated in Sect. III above, applicant expressly admits that such procedures are well-known in the art. Information which is well known in the art need not be described in detail in the specification. See, e.g., *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d at 1379-80, 231 USPQ at 94. Thus, the rejection is obviated.

Attorney Docket # 3415-11

Serial No. 09/587,201
Amtd. dated November 17, 2003
Reply to Office Action dated July 16, 2003

In ¶16(e), the Examiner alleged that the phrase "storing the tote within a mesh before placing the tote into the case" as recited in Claim 47 is indefinite, although the Examiner did not indicate how or why the phrase was indefinite. It was assumed the Examiner believed the term "mesh" rather than "mesh net" rendered the claim indefinite. Claim 47 has been cancelled and its limitations absorbed by independent Claim 46. Instead of the term "mesh" as was recited in cancelled Claim 47, the phrase "one of a mesh net and a bag" is used in amended Claim 47, and is believed to be adequately definite.

For at least the reasons above, amended Claims 6, 7, 11, 15, 26, 37, and 47 are not indefinite, and withdrawal of the rejection is respectfully requested.

V. Rejection of Claims 1-3, 6, 7, 13, 30-34, and 43
under §102(b) & §103(a) over Wilson

The Examiner rejected independent Claims 1 and 30, as well as Claims 2-3, 6, 7, 13, 31-34, and 43 depending therefrom, under 35 USC §102(b) as anticipated by *Wilson et al.* (Office Action, ¶18); and, alternately, under 35 USC §103(a) as unpatentable over *Wilson et al.* (Office Action, ¶22).

Wilson describes a safety locking mechanism for use in bakery delivery trucks. The safety mechanism operates in a similar manner to a train's 'deadman's switch': trays which are slid into racks in the back of the bakery truck are locked in place by a control handle positioned above the driver's seat — the driver must move the control handle, thus engaging the safety lock, in order to sit in the driver's seat. Engaging the safety lock causes elongated stop members to lock the trays on the rails in the racks, thereby avoiding the danger of the trays sliding off the racks while the bakery truck is in motion.

By contrast, independent Claim 1 of the present invention recites a method in which a grocery item ordered by a customer is placed into a tote, and the loaded tote is placed in a removable rack in a warehouse. Later, the removable rack is moved from the warehouse into a first vehicle, which is dispatched to deliver the grocery item.

Anticipation under 35 U.S.C. §102 requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2D (BNA) 1051, 1053

Attorney Docket # 3415-11

Serial No. **09/587,201**
Amdt. dated November 17, 2003
Reply to Office Action dated July 16, 2003

(Fed. Cir. 1987). If the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is "inherent" in its disclosure.

As admitted by the Examiner, *Wilson* does not teach every element in Claim 1, and, thus, the Examiner is relying upon inherency to find anticipation of Claim 1 by *Wilson*.

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2D (BNA) 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* at 1269, 20 U.S.P.Q.2D (BNA) at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981).

Claim 1 has, among other elements, the step of placing a tote onto a removable rack in a warehouse, and the later step of moving that rack with the tote into a first vehicle. There is no reason to think, or to assume, or even to hypothesize, that a removable rack which holds a tote loaded with a grocery item is "necessarily present" in *Wilson*. Thus, at least for this reason, *Wilson* does not anticipate Claim 1 of the present invention under 35 U.S.C. §102.

The Examiner alternately rejects these claims as obvious under 35 U.S.C. §103(a) (Office Action, ¶22). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner has not made a *prima facie* case of obviousness because (1) *Wilson* does not teach or suggest all the claim limitations; and (2) he has not provided the suggestion or motivation for making the drastic modifications of *Wilson* that would be necessary to render the present invention obvious. For example, the rack recited in Claim 1 of the present invention, which moves from the warehouse into the first vehicle, is neither taught nor suggested by

Attorney Docket # 3415-11

Serial No. **09/587,201**
Amdt. dated November 17, 2003
Reply to Office Action dated July 16, 2003

Wilson. Furthermore, the motivation to make modify *Wilson* so drastically, i.e., to change *Wilson* so completely, as to create the present invention is only provided by applicant's disclosure of the present invention.

In summary, Claim 1 of the present application is neither anticipated under 35 U.S.C. §102 by, nor obvious under 35 U.S.C. §103 in light of, *Wilson* for at least the reasons given above. Therefore, withdrawal of the rejections is respectfully requested. For the same reasons, independent Claim 30 is also believed to be patentable over *Wilson*. Withdrawal of its rejection is also respectfully requested. At least because they depend from independent Claims 1 and 30, which are believed to be patentable over *Wilson*, dependent Claims 2-3, 6, 7, 13, 31-34, and 43 are also believed to be patentable over *Wilson*; withdrawal of their rejection is respectfully requested.

VI. Rejection of Claims 46 and 47
under §102(b) & §103(a) over Sone

The Examiner rejected independent Claim 46 and Claim 47 depending therefrom under 35 USC §102(b) as anticipated by *Sone* (Office Action, ¶19), and, alternately, under 35 USC §103(a) as unpatentable over *Sone* (Office Action, ¶23). In response, applicant has amended Claim 46. Claim 47 has been cancelled, ergo its rejection is moot.

Sone describes an "automatic replenishment system" in which both a refrigerated and unrefrigerated compartment are installed into the side of a house so that the compartments have both an inside door for the resident/user and an outside door for delivery (see Abstract, FIGS. 1 and 2, *Sone*). The compartments are "intelligent", meaning that sensors monitor the inventory of items within the compartments and the system automatically contacts vendors to replenish the inventory when necessary.

By contrast, amended independent Claim 46 recites a method in which a grocery item ordered by a customer is first placed into a tote. At the delivery location, the loaded tote is secured in one of a mesh net and a bag, and the secured and loaded tote is placed into a box outside the delivery destination. In other words, amended independent Claim 46 recites a multi-tiered hierarchy of storage modules for securing the originally ordered grocery item outside the delivery destination.

Anticipation under 35 U.S.C. §102 requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Attorney Docket # 3415-11

Serial No. 09/587,201
Amdt. dated November 17, 2003
Reply to Office Action dated July 16, 2003

Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 U.S.P.Q.2D (BNA) 1051, 1053 (Fed. Cir. 1987). If the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is "inherent" in its disclosure.

Sone teaches neither "securing the tote within one of a mesh net and a bag" nor "placing the one of a mesh net and a bag containing the tote that contains the grocery item into a box outside a delivery destination", both of which are elements recited in amended Claim 46. *Sone* does not teach a mesh net/bag containing a tote, which, in turn, contains a grocery item. Furthermore, *Sone* does not teach a mesh net/bag which is stored in a collapsed state in a box at the delivery location. Further still, *Sone* does not teach a storage box *outside* the delivery destination.

At another section of the Office Action, the Examiner suggests that whatever features are not disclosed by *Sone* are nonetheless inherent in *Sone* (Office Action, ¶23). The features of amended independent Claim 46 are not inherent in *Sone*.

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2D (BNA) 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* at 1269, 20 U.S.P.Q.2D (BNA) at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981).

Amended independent Claim 46 has, among other elements, the step of securing the tote within one of a mesh net and a bag, and then the step of placing the one of a mesh net and a bag containing the tote that contains the grocery item into a box outside a delivery destination. There is no reason to think, or to assume, or even to hypothesize, that a collapsible/expandable mesh net/bag is "necessarily present" in *Sone*. Thus, at least for this reason, *Sone* does not anticipate Claim 1 of the present invention under 35 U.S.C. §102.

The Examiner alternately rejects Claim 46 as obvious under 35 U.S.C. §103(a) over *Sone* and Official Notice (Office Action, ¶23). Specifically, the Examiner "takes Official Notice that bags (totes) are used to transport articles and delivery groceries" and "that mesh bags are used to deliver and store articles".

Attorney Docket # 3415-11

Serial No. **09/587,201**
Amdt. dated November 17, 2003
Reply to Office Action dated July 16, 2003

First, it should be noted that the Examiner is relying heavily on "Official Notice" for this §103(a) rejection. As stated in the MPEP regarding an Examiner relying on Official Notice: "It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.")." (MPEP §2144.03). In this particular case, the Examiner is almost relying entirely on Official Notice, since the arrangement of elements recited in independent Claim 46 is neither taught nor suggested by *Sone*. Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection). At least because this rejection is based on general conclusions without specific factual findings and some concrete evidence in the record to support those findings, this rejection is not appropriately supported, and should be withdrawn.

Second, even if one were to accept the Examiner's Official Notice, the combination of the Official Notice and *Sone* do *not* teach all of the elements of amended independent Claim 46. In ¶23 of the Office Action, the Examiner merely takes Official Notice that bags, totes, and mesh bags are used to "deliver and store" articles and groceries. However, independent Claim 46 describes a "hierarchy of containment structures" comprised of at least three types of containment structure: the tote, the mesh net/bag, and the box. The tote is used to hold the grocery item. The mesh net/bag is stored in the box at the delivery destination, until it is used to secure a loaded tote into the box. Neither *Sone* nor the combination of *Sone* and the Examiner's Official Notice teach or suggest the "hierarchy of containment structures" recited in amended independent Claim 46, where that hierarchy includes a tote, a mesh net/bag, and a box. At least because the combination of *Sone* and Official Notice does not teach the hierarchy of

Attorney Docket # 3415-11

Serial No. 09/587,201
Amdt. dated November 17, 2003
Reply to Office Action dated July 16, 2003

containment structures recited in Claim 47, amended independent Claim 47 is patentable over the combination of *Sone* and Official Notice.

In summary, amended independent Claim 46 of the present application is neither anticipated under 35 U.S.C. §102 by *Sone*, nor obvious under 35 U.S.C. §103 over the combination of *Sone* and Official Notice for at least the reasons given above. Therefore, withdrawal of the rejection of Claim 46 is respectfully requested. For the same reasons, independent Claim 30 is also believed to be patentable over *Wilson*. Withdrawal of its rejection is also respectfully requested. At least because they depend from independent Claims 1 and 30, which are believed to be patentable over *Wilson*, dependent Claims 2-3, 6, 7, 13, 31-34, and 43 are also believed to be patentable over *Wilson*; withdrawal of their rejection is respectfully requested.

VII. Rejection of Claims 1, 8-13, 46, and 47
under §102(b) as anticipated by *Liposky*

The Examiner rejected Claims 1, 8-13, 46, and 47 were rejected under 35 USC §102(b) as anticipated by *Liposky et al.* (Office Action, ¶20). Claim 47 has been cancelled, ergo its rejection is moot.

Liposky describes a bag chained to the door of a retail store, where the chained bag is used to store bakery goods. The specific use for the chained bag in *Liposky* is for the delivery of bakery products to closed and locked stores early in the morning.

By contrast, amended independent Claim 1 of the present invention recites a method in which a grocery item ordered by a customer is placed into a tote, and the loaded tote is placed in a removable rack in a warehouse. Later, the removable rack is moved from the warehouse into a first vehicle, which is dispatched to deliver the grocery item contained within the tote. In other words, amended independent Claim 1 recites a multi-tiered hierarchy of storage modules for securing the originally ordered grocery item outside a delivery destination.

Anticipation under 35 U.S.C. §102 requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2D (BNA) 1051, 1053 (Fed. Cir. 1987). If the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is "inherent" in its disclosure.

Attorney Docket # 3415-11

Serial No. 09/587,201
Amdt. dated November 17, 2003
Reply to Office Action dated July 16, 2003

Liposky does not teach every element in Claim 1. For example, *Liposky* does not disclose a rack of any kind for holding anything. *Liposky* does not disclose putting a grocery item in a tote, where the tote is placed upon a removable rack of any kind.

The Examiner tacitly admits that he is relying upon inherency to find anticipation of Claim 1 by *Liposky* (Office Action, ¶20).

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2D (BNA) 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* at 1269, 20 U.S.P.Q.2D (BNA) at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981)).

Claim 1 has, among other elements, the step of placing a tote onto a removable rack in a warehouse, and the later step of moving that rack with the tote into a first vehicle. There is no reason to think, or to assume, or even to hypothesize, that a removable rack which holds a tote loaded with a grocery item is "necessarily present" in *Liposky*. Thus, at least for this reason, *Liposky* does not anticipate Claim 1 of the present invention under 35 U.S.C. §102.

Therefore, Claim 1 of the present application is not anticipated under 35 U.S.C. §102 by *Liposky* for at least the reasons given above. Therefore, withdrawal of its rejection is respectfully requested. At least because they depend from independent Claim 1, which is believed to not be anticipated by *Liposky*, dependent Claims 8-13 are also believed to not be anticipated by *Liposky*; withdrawal of their rejection is also respectfully requested.

Amended independent Claim 46 recites a method in which a grocery item ordered by a customer is first placed into a tote. At the delivery location, the loaded tote is secured in one of a mesh net and a bag, and the secured and loaded tote is placed into a box outside the delivery destination. Amended independent Claim 46 recites a multi-tiered hierarchy of storage modules for securing the originally ordered grocery item outside the delivery destination.

Amended independent Claim 46 has, among other elements, the step of securing the tote within one of a mesh net and a bag, and then the step of placing the one of a mesh net and a bag containing the tote that contains the grocery item into a box outside a delivery destination. There is

Attorney Docket # 3415-11

Serial No. 09/587,201
Amdt. dated November 17, 2003
Reply to Office Action dated July 16, 2003

no reason to think, or to assume, or even to hypothesize, that a box outside the delivery destination is "necessarily present" in *Liposky*. In fact, there would be no need for such a box in *Liposky*. Thus, at least for this reason, *Liposky* does not anticipate Claim 46 of the present invention under 35 U.S.C. §102.

VIII. Rejection of Claims 1-13, 15-23, 25-43, and 45
under §103(a) over *Sone* and *Liposky*

The Examiner rejected independent Claims 1, 16, and 30, as well as Claims 2-13, 15, 17-23, 25-29, 31-43, and 45 depending therefrom, under 35 USC §103(a) as unpatentable over *Sone* in view of *Liposky et al.* (Office Action, ¶24).

Both *Sone* and *Liposky* have been described above. Independent Claims 1 and 30 have also been described above.

Independent Claim 16 recites a method using a multi-tiered hierarchy of storage modules to for secure an ordered grocery item outside a delivery destination. First, a grocery item ordered by a customer is placed into a tote. At the delivery location, the loaded tote is placed into a secure expandable bag situated outside the delivery destination.

As mentioned above, to establish a *prima facie* case of obviousness, there must be some teaching, suggestion, or incentive supporting the combination of two references in order to establish obviousness (*In re Geiger*, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987)). This teaching, suggestion, or motivation may be found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The teaching or suggestion to make the claimed combination must be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). There is no teaching, suggestion, motivation, or incentive, either implicit or explicit, to combine *Sone* and *Lipowsky*. *Sone* is directed to an automated inventory replenishment system for a consumer household, while *Lipowsky* describes a bag chained to the door of a grocery store, where the chained bag is used to temporarily hold bread before the store opens.

"When the incentive to combine the teachings is not readily apparent, it is the duty of the Examiner to explain why combination of the reference teachings is proper ... Absent such reasons or incentives, the teachings of the references are not combinable" (*Ex Parte Skinner*, 2 USPQ 2d

Attorney Docket # 3415-11

Serial No. 09/587,201
Amdt. dated November 17, 2003
Reply to Office Action dated July 16, 2003

1788 (B.P.A.I. 1987)). The following passage, as far as applicant can tell, is intended to be the Examiner's explanation of the motivation to combine these two references:

Sone does not directly disclose a bag to store the delivered bread. Lipowsky teaches storing the bread in the described bag. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Wilson as taught by Lipowsky and include Lipowsky's storage bag. Such a modification would have helped prevent the bread or goods from becoming wet and moldy.

(Office Action, ¶24)

This passage from the Office Action does not help clarify what the incentive is for combining *Sone* and *Lipowsky*. At least because there is no reason or incentive explained by the Examiner for combining these two references, "the teachings of the references are not combinable". At least on this basis, withdrawal of the rejection is respectfully requested.

As was also mentioned above, to establish a *prima facie* case of obviousness, the prior art references when combined must teach or suggest all the claim limitations. Independent Claims 1, 16, and 30 recite a "hierarchy of containment structures" comprised of at least three types of containment structure: the tote, the mesh net/bag, and the box. The tote is used to hold the grocery item. The mesh net/bag is stored in, and/or attached to, the box at the delivery destination, and the mesh net/bag is used to secure a loaded tote into the box. The combination of *Sone* and *Lipowsky* neither teaches or suggests the "hierarchy of containment structures" recited in Claims 1, 16, and 30, where that hierarchy includes a tote, a mesh net/bag, and a box. At least because the combination of *Sone* and *Lipowsky* does not teach the hierarchy of containment structures recited in Claims 1, 16, and 30, amended independent Claims 1, 16, and 30 are patentable over the combination of *Sone* and *Lipowsky*.

At least for the reasons stated above, independent Claims 1, 16, and 30 are believed to be patentable over the combination of *Sone* and *Lipowsky*. Withdrawal of their rejection is respectfully requested. At least because they depend from independent Claims 1, 16, and 30, which are believed to be patentable over the combination of *Sone* and *Lipowsky*, dependent Claims 2-13, 15, 17-23, 25-29, 31-43, and 45 are also believed to be patentable over the combination of *Sone* and *Lipowsky*; withdrawal of their rejection is also respectfully requested.

Attorney Docket # 3415-11

Serial No. 09/587,201
Amdt. dated November 17, 2003
Reply to Office Action dated July 16, 2003

IX. Rejection of Claims 14, 24, and 44
under §103(a) over *Liposky*

The Examiner rejected dependent Claims 14, 24, and 44 under 35 USC §103(a) as unpatentable over *Liposky et al.* (Office Action, ¶25). At least because Claims 14, 24, and 44 depend from independent Claims 1, 16, and 30, respectively, which are patentable over the combination of *Sone* and *Lipowsky* (see Sect. VIII above), dependent Claims 14, 24, and 44 are also patentable over the combination of *Sone* and *Lipowsky*. This necessarily means that Claims 14, 24, and 44 are also patentable over *Lipowsky* alone. Withdrawal of the rejection is respectfully requested.

X. Rejection of Claims 1-47
under §103(a) over *Peapod*, *Sone*, and *Liposky*

The Examiner rejected all of the pending claims under 35 USC §103(a) as unpatentable over the *Peapod* website in view of *Sone* and in further view of *Liposky* (Office Action, ¶26).

As argued above, there is no motivation or suggestion to combine *Sone* and *Lipowsky*. Similarly, there is no suggestion or motivation to combine *Peapod*, *Sone*, and *Lipowsky*. Although one might argue that there is a suggestion or motivation to combine *Peapod* and *Sone*, it is difficult to imagine a motivation to combine *Peapod* and *Lipowsky*, except, of course, the disclosure of the present invention. At least because there is no motivation or suggestion to combine *Peapod*, *Sone*, and *Lipowsky*, amended independent Claims 1, 16, 30, and 46 can not be found obvious over the combination of *Peapod*, *Sone*, and *Lipowsky*.

Furthermore, the combination of *Peapod*, *Sone*, and *Lipowsky* do not teach or suggest all the claim limitations in any of independent Claims 1, 16, 30, and 46. Independent Claims 1, 16, 30, and 46 each recite a "hierarchy of containment structures" comprised of at least three types of containment structure: the tote, the mesh net/bag, and the box. The tote is used to hold the grocery item. The mesh net/bag is stored in, and/or attached to, the box at the delivery destination, and the mesh net/bag is used to secure a loaded tote into the box. The combination of *Peapod*, *Sone*, and *Lipowsky* neither teaches or suggests the "hierarchy of containment structures" recited in Claims 1, 16, and 30, where that hierarchy includes a tote, a mesh net/bag,

Attorney Docket # 3415-11

Serial No. **09/587,201**
Amdt. dated November 17, 2003
Reply to Office Action dated July 16, 2003

and a box. At least because the combination of Peapod, Sone, and Liposky does not teach the hierarchy of containment structures recited in Claims 1, 16, 30, and 46, amended independent Claims 1, 16, 30, and 46 are patentable over the combination of Peapod, Sone, and Liposky.

At least for the reasons stated above, independent Claims 1, 16, 30, and 46 are believed to be patentable over the combination of Peapod, Sone, and Liposky. Withdrawal of their rejection is respectfully requested. At least because they depend from independent Claims 1, 16, 30, and 46, which are believed to be patentable over the combination of Peapod, Sone, and Liposky, dependent Claims 2-15, 17-29, and 31-45 are also believed to be patentable over the combination of Peapod, Sone, and Liposky, and withdrawal of their rejection is also respectfully requested.

XI. Examiner's requirement
concerning lexicography

The Examiner stated that "[f]ailure by Applicant in his next response" to "expressly indicate" any claim limitation which may have "a meaning other than its ordinary and accustom [sic] meaning" "will be considered a desire by Applicant to forgo lexicography in this application" (Office Action, ¶¶29-30). In other words, applicant must identify any and all claim limitations which arguably have a meaning other than its ordinary and "accustom" [sic] meaning.

Applicant believes that the Examiner can require applicant to define any claim limitation to which the Examiner specifically points in the present application. Applicant believes that the Examiner can require applicant to indicate, *in regards to a specified claim limitation*, whether the words used therein are used in "other than their ordinary and accustomed meaning". Applicant does not believe the Examiner can require applicant to cite every possible term which might be considered by the Examiner to have "a meaning other than its ordinary and accustom meaning".

Because applicant does not believe the Examiner can require applicant to do this, applicant respectfully requests that the Examiner reconsider this requirement. Upon reconsideration, the Examiner is respectfully requested either to withdraw the requirement or to repeat the requirement again so that applicant can file a Petition to the Commissioner under §1.181(c).

Similarly, applicant believes that it is improper for the Examiner to provide "definitions" without providing any specific guidance to the applicant as to how the Examiner is applying those

Attorney Docket # 3415-11

Serial No. **09/587,201**
Amdt. dated November 17, 2003
Reply to Office Action dated July 16, 2003

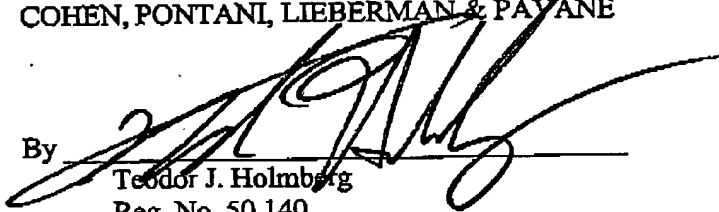
definitions to the claims (see ¶30). Without specific application to the claims, it is difficult to impossible to tell whether applicant needs to respond to these "adopted" definitions. Because applicant does not believe the Examiner can "adopt" definitions without indicating to the applicant how those definitions are being *specifically* applied to the claims in any of the Examiner's objections or rejections, applicant respectfully requests that the Examiner reconsider this action. Upon reconsideration, the Examiner is respectfully requested either to withdraw the action or to repeat the action again so that applicant can file a Petition to the Commissioner under §1.181(c).

Applicant believes all pending claims are in condition for allowance, which is respectfully requested.

Respectfully submitted,

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